Rejections – 35 U.S.C §103(a)

In an office action mailed May 27, 2004, the Examiner rejected claims 1-8 under 35 U.S.C. §103(a) as being unpatentable over Jones in view of Potter. Applicant respectfully disagrees with Examiner's contentions and for the reasons below respectfully request reconsideration.

In order to maintain a §103 rejection, the Examiner has the burden of providing evidence of prima facie obviousness. See MPEP §2143. See also In Re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). In order to prove prima facie obviousness, the Examiner must provide evidence in the prior art of a motivation to combine or modify a reference, a reasonable expectation of success, and a teaching of each and every claimed element. Id.

Turning first to claim 1, the Applicant respectfully turns the Examiner's attention to the fact that claim 1 as originally presented contains two potential methods of payout; first, a wager may be placed on whether the two turned cards are of the same suit, referred to in the specification as a "No-Call" result, and a second, additional, wager may be placed on a "secondary result". These payouts are of course in addition to any payouts that result from the normal rules of craps.

It is respectfully asserted that the combination of payouts resulting from the No-Call result, the additional secondary criteria result, and the normal payouts of craps are neither taught nor suggested in the prior art of record.

Turning first to the Jones reference, a dice-less craps game is disclosed. However, the teaching of the Jones reference is limited to simply replacing the pair of craps dice with a

random umber generator of some other means. Moreover, there is no teaching or even suggestion of providing additional (non-craps) payouts.

The Examiners admits that Jones fails to disclose a same-suit payout as presently claimed in claim 1, but the Applicant asserts that Jones fails to suggest *any* additional non-craps payout. For example, once the two random numbers are generated, Jones teaches "[t]he play is by craps rules"(Col. 4, Line 20).

More particularly, Jones states:

> "the sum of the pair of selected numbers 40 are displayed on the CRT 36 and the split screen monitor 38. The sum of the pair of selected numbers displayed constitute the random number decision generation replacing the use of dice and play resulting from the decision will proceed according to the conventional craps rules." (Col. 6, Lines 46-51)

Hence, it is clear that the teachings of Jones are limited to the payout scheme of conventional craps games, and additional non-craps payouts are simply not provided for in ones.

To reach the additional non-craps payouts provided by the invention as claimed, the Examiner cites Potter et al. However, Potter et al., is flawed for several reasons.

Potter et al., provides additional payouts in addition to the payouts of a "base casino game" that are based "on the outcome of a random event or multiple random events that takes place before the base casino game begins". (Abstract)

Importantly, the payouts of Potter et al., bear no connection whatsoever to the base casino game and played out separately from the underlying game, this in fact being the primary object of the Potter et al., specification. In other words, the advantage purported by the Potter reference is that it may be incorporated into play with many base casino games as the rules of the underlying base game do not change.

Applicant notes the additional payouts of the present invention as recited in claim 1 are, in contrast, integral to the game itself, and in fact occur after the base game of dice-less card craps has begun, as play proceeds as claimed in the present application only if cards are draw of different suits. Hence, Applicant respectfully asserts that to modify the Potter game to become integral to the Jones game would be an improper modification of the Potter reference, and the rejection should be removed for this reason.

Moreover, the Jones game would also be required to be substantially modified to operate in the manner of the present invention as the Examiner suggests. The Jones reference only discloses the use of numerical cards provided for the sole purpose of generating random numbers normally generated by a pair of dice. Jones discloses no provision for the utilization of suited playing cards, or for the modification of the rules of conventional craps to account for additional payouts resulting therefrom.

Thus, to reach the present invention as claimed, the Examiner must first modify the Jones game to now include additional, non-craps, payouts, and secondly, modify the Potter game to provide for payouts during the underlying Jones game, in direct contradiction of the teachings of both references. It is improper for the Examiner to use such hindsight and substantially modify both references of record to arrive at the invention as claimed. Applicant respectfully asserts that the requirement of such substantial

modifications to the cited references provides strong evidence of the non-obviousness of the pending claims. The rejection should be removed for this additional reason.

Additionally, Applicant asserts that Potter in fact teaches away from the present invention as claimed because it the very aim of the Potter game to be played *prior* to the base casino game beginning, while the payouts of the present invention are paid *during* the normal course of the claimed game. The fact that Potter teaches away is further evidence of the non-obviousness of the present claims. The rejection should be removed for yet this additional reason.

Turing to the dependent claims, claims 2-8 depend either directly or indirectly from base claim 1. As Applicant believes that claim 1 is allowable for the reasons stated above, it is believed that claims 2-8 are allowable as depending from an allowable base claims, the rejection should be removed for this reason.

If the Examiner has any questions regarding this application, the Examiner may telephone the undersigned at 775-586-9500.

Respectfully submitted,
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